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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,708	12/17/1999	FUMIKO SEMBA	FUJI-16.863	9208

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KATTEN MUCHIN ROSENMAN LLP
575 MADISON AVENUE
NEW YORK, NY 10022-2585

EXAMINER

AL AUBAIDI, RASHA S

ART UNIT	PAPER NUMBER
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2614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/465,708

Applicant(s)

SEMBA ET AL.

Examiner

Rasha S. AL-Aubaidi

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the petition filed 10/10/2006 and the petition decision filed 01/09/2007, the final office action has been remailed.

Response to Amendment

2. Applicant's amendment filed on 11/28/ 2005 has been entered. Claims 14-16 have been amended. No further claims have been canceled. No claims have been added. Claims 14-16 are still pending in this application, with claims 14, 15 and 16 being independent.

Claim Rejections - 35 USC § 103

3. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al (US Patent 6,574,216) hereinafter '216 in view of Farris (US PAT # 6,064,653) hereinafter '653.

Regarding claim 14, Farris '216 specifically teaches the switching of a telephone call in progress, and currently connected via the Internet (50, Fig. 3) to another non-internet network (PSTN 10, Fig. 3) in order to **improve voice quality**. See abstract, col. 9, lines 35-58 and col. 11, lines 22-58. The claimed "exchange" reads on the combination of SSP 13 and Internet module 92. Pressing the "*" digit on the caller's telephone 11 during an economical Internet call will switch the call from Internet 50 to the PSTN 10 to improve the voice quality. The Internet may be selected when the caller

dials a code such as *82 or based on the caller's routing criteria in his/her CPR (col. 9, lines 35-58).

Farris '216 differs from the claims only in the way the caller signals his/her desire to switch from the Internet to PSTN during a telephone call via the Internet. In Farris '216, the caller signals his/her desire to switch from the Internet to PSTN by dialing the "*" digit which is detected by Internet module 92 during a telephone call via the Internet. However, in the claimed invention, the caller signals his/her desire to switch from the Internet to PSTN by pushing a button after a "quick" on-hook/flash operation during a telephone call via the Internet.

The difference is merely in the specific way the caller signals the exchange ("SSP 13 and module 92"). The use of on-hook/flash operation to signal an exchange is old and well known. For example, a quick or temporary on-hook or flash operation maybe used to establish a conference call, to answer a call in response to a call waiting tone ... etc. Thus, obviously one of ordinary skill in the art may use any type of signal ("*" in Farris, or pushing a button after a flash operation in the claims) in order to accomplish the same exact result for the same exact purpose. Simply using another signal in Farris '216 does not rise to the level of patentability.

When the calling party in Farris '216 desires to switch the call from the Internet to the PSTN, he/she dials *82 only. The calling party does not dial the telephone number

of the called party when he/she decides to switch from the Internet to PSTN. The PSTN will inherently need the number of the called party to connect the calling party to the called party. Therefore, it is inherent that the "exchange" in Farris '216 will have to store the telephone number of the called party to effect the switching. In both, the claimed invention and Farris '216, the connection through the Internet has to be disconnected and a new connection through the PSTN has to be "originated"; thus "re-originating" the call between the calling and the called parties.

Farris '216 does not specifically teach disconnecting the established call connection via a second trunk from the PSTN and re-originating the call to the calling party through the Internet via a first trunk.

However, Farris '653 specifically teaches that calls, which are established via PSTN, can be re-routed from the PSTN to the data network, when the condition of the data network improves (see abstract of the invention and col. 5, lines 42-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of switching from the PSTN to data network when the condition of the data network improves, as taught by '653, into the '216 system in order to reduce the cost to the calling party by switching to the internet which is more economical than the PSTN.

Claims 15-16 are rejected for the same reasons as discussed above with respect to claim 11.

Response to Arguments

4. Applicant's arguments filed 11/28/2005 have been fully considered but they are not persuasive.

Regarding the foreign priority under 35 U.S.C. 119, Examiner made the proper changes (see attached PTO-326, box 12a, 1).

Regarding applicant's request that the "Examiner indicate acceptance of the drawings". Acceptance of the drawings already made in the office action mailed on 07/27/2005.

Applicant argues that "Farris et al. and Farris, as applied by the Examiner, do not appear to describe any scheme whereby a call may be re-originated after disconnection during a network switch". Examiner respectfully disagrees with applicant's argument, since Examiner specifically stated that in both, the claimed invention and Farris '216, the connection through the Internet has to be disconnected and a new connection through the PSTN has to be "originated"; thus "re-originating" the call between the calling and the called parties.

Also, applicant argues that “The Examiner appears to have failed to, otherwise, address where the calling number can be found after the call is disconnected”. Clearly, the Examiner indicated that the PSTN inherently needs the number of the called party to connect the calling party to the called party. The use of the term “inherently” for any limitation basically means that the limitation is needed in the reference, even if the reference does not exactly teach it. Even though, Farris ‘216 does not explicitly teach the use of a calling number. However, Farris ‘216 specifically teaches the use of call processing records (CPR) for each subscriber. Those records are stored in the database (see col. 7, lines 61-67). CPRs contain information about calls related to subscriber beside some other information (see col. 9, lines 50-55). Therefor, applicant argument is not convincing.

In addition, Applicant argues “Farris et al. do not contemplate the scenario of a call being disconnected and thereafter re-originated in an alternative networks part of the switching”. Again, Examiner respectfully disagrees with applicant’s argument because the Examiner acknowledges that Farris et al. ‘216 lacks the teaching of disconnecting from one network and re-originating to another network. However, Examiner introduced Farris ‘653, which specifically teaches that calls can be re-routed from the PSTN to the data network (abstract and col. 5, lines 42-46). This basically means that the call no longer exists in the first network and it is established in the second network. Rerouting the call from one network to another is read as the claimed feature of “disconnecting the call” from one network and “re-originating the call” to

another network, both lead to the same end result, which is moving the call from one network to another network.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

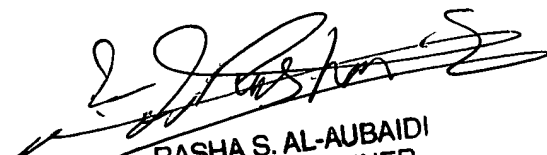
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rasha S AL-Aubaidi whose telephone number is (571) 272-7481. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar, can be reached on (571) 272-7488.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner
Rasha. S Al-Aubaidi
Art unit 2642
01/20/2007



RASHA S. AL-AUBAIDI
PATENT EXAMINER